

Application/Control No. 10/671,731

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims supersedes any previous listing. Favorable reexamination and reconsideration is respectfully requested in view of the preceding amendments and the following remarks.

Rejections under 35 USC § 112

The claims have been amended in a manner which renders them both clear and distinct. Indeed, the claims have been amended to the degree that they are allowable over the art and are free of any shortcomings under § 112.

However, it appears that there is some confusion as to the difference between lack of written support for broadly claimed subject matter, and new matter - see page 2 of this Office Action. There was no new matter introduced into the claims. Indeed, at page 3 lines 3-4 of this Office Action, it is clearly admitted that "the specification provides guidance **for certain specific plants** comprising . . ." (Emphasis added). Attention is also called to the originally filed claims.

How could what is set forth in the claims submitted in the response dated August 17, 2006, now represent "new matter?"

Thus, the amendments which limit the disclosed plants to grass is seen as rendering the rejections under 35 USC § 112 moot. Indeed, the amendments are such as to bring the claims into compliance with the limits stated on page 3, lines 3-9 of this Office Action.

At the top of page 4, the office action makes reference to product-by-process. In fact, the following anticipation rejections under § 102 are replete with multiple references to the claims being set forth in product-by-process form and the

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ramifications thereof. It appears as if this position has been totally relied upon to apply art as if the products of the cited references were in fact the same as those which are defined in the rejected claims. The rejections, however, fail to establish why or how the claims should be considered to be cast in product-by-process form.

Claim 1 (cancelled in this action), for example, called for "A plant comprising a symbiotic fungus." The remainder of this claim set forth limitations pertaining to the fungus calling for the fungus to be selected to produce chanoclavine as a final metabolic product. How is this a product-by-process claim?

In this response claim 4 has been written into independent form via the inclusion of the subject matter of claims 1-3. The remaining claims have been amended in accordance with the amendments to claim 4.

Rejections under 35 USC § 102

1) The rejection of claims 4-7 under 35 USC § 102(b) as being anticipated by Porter et al., is respectfully traversed.

First, the claims are not product-by-process claims. Nothing has been advanced to establish this, and clearly the form of the claims do not remotely support this position.

Indeed, in the paragraph spanning pages 4 and 5 of this Office Action, the content of the claims is summarized in a manner which supports the Applicant's position. The Office Action states that the claims are broadly drawn to:

any plant that accumulates chanoclavine in the plant tissue which plant comprises a symbiotic fungus that produced chanoclavine "selected" to produce chanoclavine as a **final metabolic product** and where the chanoclavine is

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accumulated in the plant tissue. (Emphasis added)

The rejection therefore acknowledges that the claimed subject matter is clearly understood to require that that chanoclavine is the final metabolic product - yet blatantly ignores this requirement when considering the teachings of Porter et al.

Presumably, the rejection is ignoring this requirement in that the § 112 rejection takes the position that the claims are vague in that:

producing chanoclavine as a final metabolic product is such as to imply that there are many "final metabolic products.

In light of US Patent practice, it is questioned as to how an antecedent basis rejection could possibly be avoided by not using "a" final metabolic product? It would appear, if this position were to be proper, that any claim placed before the PTO could be rejected either for lacking antecedent basis or being vague.

Perhaps the Examiner would like to elucidate further on this position along with the ramification of this type of position for the sake of appeal - should it be decided that this position be maintained.

The only paragraph which is on point is that which indicates that:

Porter discloses a plant which is infected with an endophyte that produces chanoclavine. It can be reasonably **presumed** that the chanoclavine produce is found in the plant tissue at the least to some extend upon infection. (Emphasis added)

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However, as noted above, the rejection which acknowledges the requirement that chanoclavine is the final metabolic product, is flatly ignored. Further, the rejection is based on a presumption as different from actual disclosure. In that there is nothing shown to be disclosed in Porter et al. re chanoclavine being the final metabolic product, and further it can only be "presumed" that the chanoclavine produced is found in the plant tissue at the least to some extent upon infection, the rejection is submitted as failing to establish a *prima facie* case of anticipation.

The remainder of this §102 rejection is nothing more than boiler plate which is directed to issues and case law pertaining to "product-by-process" claims. This is neither well taken nor particularly germane to the rejection.

Rejections under the 35 USC § 102 statute, are based on the premise that to anticipate a claim, each and every element of the claim must be shown in a single reference. When a claimed element cannot be found in the reference, the reference does not anticipate the claimed invention. Further, it is incumbent upon the Examiner to identify where in the reference each element may be found. Ex parte Levy, 17 U.S.P.Q.2d 1461 (Bd. Pat. App. Infr. 1990). Consequently, when the Examiner fails to identify a claimed element or elements, the Examiner has failed to establish a *prima facie* case of anticipation.

2) The rejection of claims 1-7 under 35 USC § 102(b) as being anticipated by Cagas et al, or Petroski et al. is respectfully traversed.

This rejection suffers from the same shortcomings as that discussed above. Indeed, it repeats the statement that the claims are broadly drawn to any plant that:

accumulates chanoclavine in plant tissue,
which plant comprises a symbiotic fungus that

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produced chanoclavine, and wherein the symbiotic fungus may be many fungus or Neotyphodium or specific strains of Neotyphodium "selected" to produce chanoclavine as a final metabolic product and wherein chanoclavine is accumulated in the plant tissue.

Again, irrespective of the rejection stating that the above is clearly understood as being the claimed subject matter, fails to establish that each and very one of these claimed features is found in the references which are relied upon for anticipation.

Indeed, the rejection again contains repeated statements such as "it can be reasonable presumed . . . " however, is devoid of any specific indication that chanoclavine is disclosed in either reference as being the final metabolic product.

The Examiner's attention is called to paragraph [0006] of the instant specification which sets forth:

[0006] It is known that a grass symbiotically infected by the endophyte shows toxicity due to the presence of ergoto alkaloids. The toxicity is considered to be a problem in husbandry as it affects livestock. In the case of pasture, for example, grasses infected with the endophyte such as perennial rye grass and tall fescue are very commonly distributed, and cases of **poisoning** have been reported due to the **ergoto alkaloids**. (Emphasis added)

The claimed invention is directed to overcoming this poisoning problem due to the presence of ergoto alkaloids in the grass which is consumed by grazing animals. By spreading the claimed fungus and halting the metabolic process so that

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chanoclavine is the final metabolic product, the above-described problem can be overcome.

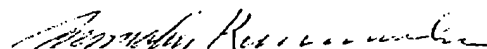
Conclusion

It is respectfully submitted that the claims as they have been amended are allowable over the art which has been applied in this Office Action. Favorable reconsideration and allowance of this application are courteously solicited. At the very least, entry of the amendments for the sake of appeal is requested.

If any further correction is required, please contact the undersigned agent.

One month extension of time is hereby requested. Please charge the extension fee (\$120.00) to Deposit Account No. 11-0219

Respectfully submitted,


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I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark office,
Fax No. 571-273-8300 on February 28, 2007.

by 
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